REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 18-37 will be active in the application subsequent to entry of this amendment.

In order to advance prosecution and more clearly define that which applicants regard as their invention a new set of claims has been provided. The original claim set included claims directed to beverage compositions as well as procedures for preparing them. The claims presented above are directed to methods for suppressing the formation of precipitate during or after heat sterilization of the beverage in the process of producing a milk-added coffee beverage (claims 18-29) as well as milk added beverage compositions as such (claims 30-37).

The description of the invention and related claims includes the use of a strongly basic substance as described in more detail on pages 9 and 10 of the specification. New claim 18 includes the requirement that phosphate salts may not be included as a strongly basic substance within the purview of claim 18 and the claims dependent from it.

While there is no specific support in the application for the precise wording of the proviso language, it is believed that the Applicants are entitled to exclude subject matter of prior art pursuant to the decision of *In re Johnson*, 194 USPQ 187 (CCPA 1977). [1]

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[1] In that case, the court quoted from its decision in *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) as follows:

"Inventions are constantly made which turn out not to be patentable, and Applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable."

The court went on to state:
"It is for the inventor to decide what bounds of protection he will seek. *In re Saunders*, 58 CCPA 1316, 1327, 444 F.2d 599, 607, 170 USPQ 213, 220 (1971). To deny applicants the benefit of the grandparent application in this case would, as this court said in Saunders:

'... let form triumph over substance, substantially eliminating the right of an Applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed.' " (Emphasis in the original)

In the *Johnson* case, the Appellants narrowed their claims to avoid them reading on a lost interference count (which was then prior art to them). The court noted that the Appellants were merely "excising the invention of another" to which they were not entitled, and were not "creating an 'artificial subgenus' or claiming 'new matter'.

New claim 19 features the addition of the strongly basic substance and/or basic amino acid before mixing the milk component with the coffee component. Previous claim 17 features the addition of the strongly basic substance and/or amino acid prior to the heating step. Claims 20-22 relate to previous claims 4, 6 and 5, respectively while claim 23 specifies that the basic substance is selected from sodium hydroxide and potassium hydroxide and is thus similar to previous claim 7 except that the phosphate salts are excluded from claim 23. Claims 24-29 relate to previous claims 8-13, respectively.

New independent composition claims 30 and 31 feature the requirement that the beverage does not contain sodium bicarbonate in an amount in excess of 0.14 wt %. Claim 31 goes on to specify that the beverage is heat sterilized and placed on the market in a hermetically sealed container. The details of the processing and packaging of the milk added coffee beverage are given in the description of the invention on page 1, lines 16-17, page 2, line 9 and the sterilization procedures at page 13, last paragraph and continuing to page 14, line 4. The terminology used in claim 31 is thus consistent with these passages of the description of the invention. New dependent claims 32-37 relate to previous claims 9, 8, 12, 13, 14 and 15, respectively.

Applicants submit that the claims presented above properly define the invention and are based upon corresponding description in the specification and claims as filed and as previously considered.

In the outstanding Official Action the Examiner has indicated claims 9 and 10 are allowable but that claims 1-8 and 11-17 are rejected on the basis of prior art. Applicants now address the prior art-based rejections to the extent, if any, they might pertain to the new set of claims presented above.

Rejection directed to claims 1-8 and 11-17 under 35 U.S.C. 102(b) as being anticipated by Sasagawa et al.

The examiner pointed out that Sasagawa et al. (USP 6,056,989) teach, for example in Example 2, a coffee beverage and process of preparing the same, where the beverage is prepared from a coffee extract from coffee beans with the addition of potassium hydroxide, and the addition of a milk component, where the same is then heat sterilized and has an adjusted pH of 6.8.

However, applicants direct the examiner's attention to the fact that Sasagawa et al. use potassium hydroxide as a pH adjustor for drinks, and hence, do not even remotely suggest the use of a strongly basic substance for preventing precipitates from being formed in a milk-added coffee beverage during or after the heat treatment.

More specifically, Sasagawa et al. employed potassium hydroxide as a pH adjustor in place of sodium salts in order to overcome the problem stated in column 1, lines 46-60 of US 6,056,989 that "the use of sodium salts such as sodium bicarbonate, disodium hydrogen phosphate and the like for pH adjustment causes saltiness, sliminess and a bad after-taste in drinks, resulting in deterioration of their characteristic aromas and tastes. It is believed that such deterioration in the aroma and taste of drinks is caused by the change in the aroma and taste balance due to the increase in the sodium ion concentration which occurs after addition of an excess amount of sodium salts to drinks which are prepared from coffee beans and various tea leaves that contain only a very small amount of the sodium ingredient".

In contrast, the invention of claims 18-29 as amended of the present application relates to a method for suppressing the formation of precipitates during or after the heat sterilization of the beverage in the process of producing a milk-added coffee beverage. Phosphate salts are excluded from the strongly basic substance used in the process. Therefore, the present invention is by no means obvious from Sasagawa et al. Moreover, NaOH is a preferred strong basic substance of the present invention, in direct contrast to Sasagawa et al.

Further, the invention of claims 30-37 after amendment of the present application relates to a milk-added coffee beverage which may contain potassium hydroxide. However, a case where the beverage contains potassium hydroxide as a sole strongly basic substance has been excluded by amendment. Thus, when the beverage contains potassium hydroxide, it also contains sodium hydroxide. Therefore, the milk-added coffee beverage is not obvious from Sasagawa et al. which teaches one to avoid the use of sodium salts.

For the above reasons it is respectfully submitted that the new claims presented above are patentably distinguished from the disclosures of Sasagawa et al.

Filed concurrently with this response is an Information Disclosure Statement citing documents that arose during examination of counterpart applications in foreign countries. To assist the Examiner in evaluating these two documents the following remarks are presented.

In China, the examiner cited Japanese Patent Public Disclosure (Kokai) No. Hei 10-75712 (D1)[2].

Phosphate salts have been excluded from the strongly basic substance in claim 18.

On the other hand, D1 discloses the use of trialkali metal phosphates to prevent precipitates from arising in milk coffee products. In China the examiner argued that D1 suggests that a milk-added coffee beverage can be produced via the process "which comprises the steps of adding a strongly basic substance to a milk component followed by adding a coffee component, and then pasteurizing by heating". Applicants disagree with the examiner. D1 repeatedly emphasizes the necessity of using a trialkali metal phosphate. For example, D1 states in paragraph (0009) that:

> *"The inventors conducted an extensive study to solve the problems of prior art. They have discovered by coincidence that, in the production process of a tightly packaged milk-containing coffee product, no gel-like precipitates are generated even in the case where the tightly packaged coffee contains a relatively great amount of coffee component, and moreover, no gel-like precipitates or rings are formed after long term storage. The inventors made further extensive study to find that the formation of gel-like precipitates is effectively prevented by the coexistence of phosphate and alkali metal ions which are introduced by addition of a trialkali metal phosphate or an equivalent thereof before the sterilization treatment, whereby the present invention has been accomplished."*

Therefore, D1 repeatedly emphasizes the importance of a phosphate to prevent gel-like precipitates in milk-added coffee products. Thus, applicants submit that it is not possible to generalize the effect of phosphates as disclosed in D1 to other strongly basic substances, still less simple basic compounds such as sodium hydroxide or potassium hydroxide, which are particularly preferred strongly basic substances employed in the present invention.

In Japan, Patent Publication (Kokoku) No. Sho 43-15793 was cited by the examiner.

JP Publication Sho 43-15793 relates to a method for improving the flavor of coffee comprising adding thereto arginine in free form. More specifically, this document teaches that it is possible to improve the palatability of lower grade coffee beverages having a relatively strong sourness by the addition of arginine in free form, without destroying the flavor. The

[2] Applicants advise an English translation of this document is not available. A concise explanation of relevance is not necessary (and is not included) as a translation of relevant portions of the Action is provided [See M.P.E.P. §609(A)(3)]

invention of this document mainly targets instant coffee, and does not have anything to do with the prevention of precipitates which often arise during or after the heat sterilization of a milk-added coffee beverage.

In order to distinguish the present invention from that of Japanese Patent Public Disclosure No. Hei 10-75712, the strongly basic substance has been limited, as explained above, by excluding the case where the beverage contains potassium hydroxide as a sole strongly basic substance in claim 30, which is directed to a milk-added coffee beverage composition and the subclaims dependent therefrom.

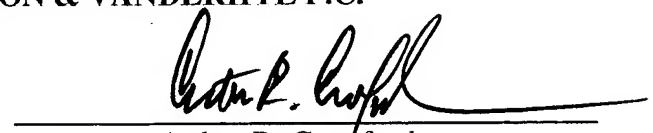
In order to distinguish the present invention from that of Japanese Patent Publication No. Sho 43-15793, a feature that "the beverage is to be heat-sterilized and placed on the market in a hermetically sealed container" has been added to claim 31, which is directed to a milk-added coffee beverage per se. and the subclaims dependent therefrom.

In order to further distinguish the present invention from those of Japanese Patent Public Disclosure No. Hei 10-75712 and Japanese Patent Publication No. Sho 43-15793, a feature that "the beverage does not contain sodium bicarbonate at an amount of more than 0.14 wt%" has been included to claims 30-37

For the above reasons it is respectfully submitted that the claims of this application define inventive subject matter. Reconsideration and favorable action are solicited. Should the Examiner require further information please contact the undersigned by telephone.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

Arthur R. Crawford
Reg. No. 25,327

ARC:pfc
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100